



2151
JFV

Application/Control Number: 09/917,050

Applicant(s): Elmer, Stefan Mark

Examiner: Nghi V Tran

Art Unit: 2151

November 9, 2004

With regards to patent application no. 09/917,050, please find enclosed:

- Drawings of the invention (1 page). As requested by the examiner.
- Applicants comments to Office Action dated September 22, 2004 (5 pages).
Original office action text is included in green text in order to facilitate reading.
Applicants comments are in black and marked by a triple vertical line to the left of the comments.
- Specification, second version (5 pages). The second version incorporates changes suggested by the examiner or proposed by the applicant, as explained in the applicant's comments to the Office Action. No new subject matter has been introduced in the specification compared to the first version.

Examiner is welcome to contact applicant by phone: +45 40 99 40 53 or +45 30 25 95 60 at any time during normal U.S. office hours.

Best regards,

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DETAILED ACTION

Drawings

1. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Applicant is given a TWO MONTH time period to submit a drawing in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit a drawing will result in **ABANDONMENT** of the application.

|| Drawing has been attached to facilitate understanding of the invention.

Specification

2. The abstract of the disclosure is objected to because there are two paragraphs. Examiner suggests changing to a single paragraph. Correction is required. See MPEP § 608.01 (b).

|| Abstract has been changed to a single paragraph.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: --Method for saving or caching Web contents with its web address and its current date and time--.

|| The originally suggested title was "Web page cache-on-demand". The "on-demand" part was meant to express the fact that the caching is done on a specific Web page upon the request of a user. In this respect, the invention differs from other systems that feature "bulk" caching, i.e. automated caching of multiple (e.g. millions) web pages.

|| The applicant has also realized that, in relation to the invention, "saving" is a more precise term than "caching", since the invention involves permanent and not temporary copies.

|| Furthermore, the usefulness of the invention lies in the fact that the web pages are both saved (steps 1-3, cf. "Detailed Description Of The Invention") and republished (step 4). The title should reflect this fact.

|| Applicant suggests the following title: --Process of saving specific web contents with its address and current date and time for subsequent online republication--

Claim Objections

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claim has not been numbered and has been renumbered --1--.

OK. Claim will be referred to as Claim 1.

5. Claim 1 is objected to because of the following informalities:

With respect to claim 1, bolding claim1 is not necessary. Examiner suggests not bolding the claim 1.

Applicant has removed bolding from claim 1.

With respect to claim 1, the phrase "Web address (URL)" appears to be incorrect. "(URL)" is not an abbreviation of "Web address". URL is the address of a web page on the World Wide Web. Therefore, "URL" is an example of the "Web address".

Applicant does not agree. URL is a technical term for an address on the World Wide Web (WWW), as defined in the application under "Detailed Description Of The Invention": "A URL is a unique Web address".

Web address and URL can be used interchangeably. It is, however, not pertinent that both terms are used. Therefore, applicant has changed "Web address (URL)" to "URL".

With respect to claim 1, the phrase "current time/date" (emphasis added) appears to be unclear. The "/" means "or", "and", or both. Therefore, examiner interprets the "/" means -- or--.

The phrase "current time/date" means "current time and date". Applicant has changed the phrase into "current time and date".

With respect to claim 1, the applicant wrote, "Web contents can be recalled later... Web address" (emphasis added). The examiner interprets the term "can be" means perhaps, possibly but not certainly. Therefore, the examiner reverse the right to give no patentable weight on any limitation right after the term "can be".

"Web content can be recalled later" means that the system gives the user the possibility to recall the Web contents later on, but it is of course up to the user whether he or she wants to use that possibility. Applicant believes "can be" is the most correct wording.

Appropriate correction is required.

Claim Rejections – 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

With respect to claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Applicant cannot find the phrase "such as" in Claim 1. Applicant has minimized the usage of the phrase elsewhere in the specification.

With respect to claim 1, claim 1 recites the limitation "the" in --a--. There is insufficient antecedent basis for this limitation in the claim.

Applicant does not understand the meaning of this statement. Applicant has reformulated Claim 1 in an attempt to make it more precise.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1 is rejected to under 35 U.S.C. 102(b) as being anticipated by Breck Witte, PC Magazine ISSN: 0888-8507 (hereinafter Witte).

With respect to claim 1, Witte teaches the process of allowing a Web user to specify and save Web contents (such as an HTML page) together with its Web address (URL) and the current time/date in an internet-connected system (with a Web interface), so that the Web contents can be recalled later in its exact form together with the retrieval time/date and the original Web address (URL) (page 205).

Applicant strongly disagrees with this statement. It appears that the examiner has not understood the contents of the mentioned PC Magazine article and that the examiner is uncritically transferring characteristics from the applicant's invention onto the article.

The PC Magazine article, along with all 6 other cited references, refer to Google's "cached pages" feature, which – as the applicant has clearly indicated in the application – is fundamentally different from the invention. The main difference is that Google's cached pages feature does not allow a user to cache pages individually and as they currently appear. With Google, the user has no control of the caching process, which is taken care of by a Web spider (robot), which crawls the Web and caches Web pages at random points of time. With the applicant's invention, the user chooses when to cache Web contents and from which URL to retrieve it. Furthermore, with respect to the invention, the user always has the option to recall a specific cached page (as it is republished after its retrieval, cf. step 4 in "Detailed Description Of The Invention"), whereas Google may delete or update a cached page at any time.

Applicant has had pleasant phone conversations with the examiner during which the examiner admitted that he had not understood the nature of the invention based on the written application and that there is indeed an important difference between the invention and Google's cached pages.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Google, "Google's New GoogleScout Feature Expands Scope of Search on the Internet," September 21, 1999, Google Inc., <http://www.google.com/press/pressrel/pressrelease4.html>, page 2 of 4
- b. Chiu, Anthony, "Stanford U. grads launch search engine Google.com," January 22, 1999, The Stanford Daily, page 1 of 2.
- c. Diaz, Karen and O'Hanlon, Nancy, "Web search Engines Evolve to Meet Challenges," March 22, 1999, Ohio State University Libraries, ISSN: 1094-9054, number 3, volume 38, page 247.
- d. Brown, Judy, "Google searches keep data pertinent," April 12, 1999, Journal Sentinel Inc., Business Section, page 2.
- e. Notess, Greg, "On-the-Fly Search Engine Analysis; Industry Overview; Column," September 1, 1999, Montana State University Libraries, ISSN: 0146-5422, number 5, volume 23, page 63.
- f. Lake, Matt and Tweney, Dylan, "Find it on the Web," May 12, 1999, CNN, <http://www.cnn.com/TECH/computing/9905/12/websearch.idg/>, page 4 of 7.

As stated above, all cited references refer to Google's "cached pages" feature, which is fundamentally different from the invention.

Applicant would also like to mention another web site which is related to, but still different from, the invention and which has come to the attention of the applicant after the application was made. The Internet Archive (<http://www.archive.org/>) is a web site which primary aim is to archive web pages so that visitors can "go back in time". The Internet Archive, however, like Google's cached pages, is based on an automatic process which does *not* allow the visitors to cache a page at the current time and date.

The table below summarizes the main differences between Google's cached pages, the Internet Archive's WayBack Machine and the applicant's invention. The differences, which separate the applicant's invention from the prior art of the other two applications, are underlined.

Parameter / Technology	Internet Archive WayBack Machine	Google Cached Pages	Applicant's Invention
Launch / patent application year	1996	1998	2001
Who decides what to archive?	<u>Robot (algorithm)</u>	<u>Robot (algorithm)</u>	<u>User (manual input)</u>
When is the page archived?	<u>At predefined intervals</u>	<u>At random (when the robot is ready)</u>	<u>At the current time (when the user requests it)</u>
When is the page displayed?	When user recalls it	When user recalls it	When user recalls it
When is the page deleted?	Never	At random (next time the robot visits the page)	Never
Purpose	Go back to view historic Web pages	Go back to view historic Web pages	Save Web pages for future display

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V Tran whose telephone number is (571) 272 4067. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful,...

Applicant has had pleasant phone conversations with the examiner, who seemed approving of the viewpoints of the applicant, and who admitted that he had not previously fully understood the nature of the invention. Applicant promised to send in drawings and a written reply to the office action.